

REMARKS

Claims 17-19 and 23 stand previously allowed.

Claims 13 and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Black et al (US 6,494,305) in view of Chapman et al (US 3,651,704) and Blankenship et al (US 6,267,291). Claims 14 and 20-22 stand rejected under 35 U.S.C. § 103(a) as being obvious over Black ('305) in view of Chapman ('704), Blankenship ('291), and Fleischer (US 4,697,278). Claim 16 stands rejected under 35 U.S.C. § 103(a) as being obvious over Black ('305) in view of Chapman ('704), Blankenship ('291), and Rohrig (US 4,717,370). Claim 24 is newly added. Claims 13-22 and 24 are addressed below.

Claim 13

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

No Motivation to Combine References

Even if it would have been obvious to modify Black ('305) by Chapman ('704) to create a lighter weight system as the Examiner suggests on page 4 of the 10/17/2005 Office Action (and previously on page 4 of the 6/29/2005 Office Action), there would be absolutely no suggestion or motivation to combine the combination of Black ('305) and Chapman ('704) with Blankenship ('291), and the Examiner's combination of Black ('305), Chapman ('704), and Blankenship ('291) clearly constitutes impermissible hindsight.

In explaining the motivation to combine on page 4 of the 10/17/2005 Office Action, the Examiner writes:

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to rearrange the location of the block having the RF tag of Black et al/Chapman et al from the trolley to the surface/recess between the hub and rim as taught by Blankenship et al in

order to provide Black et al/Chapman et al with a more secure system wherein the block is mounted within the recess between the hub and the outer rim of the wheel instead of exposing on the outer surface of the trolley, and thus preventing separation of the tag from the system during conveying and handling.

This alleged separation problem is not found in any reference cited by the Examiner, and to the Applicant's knowledge, separation has not been a problem experienced in the prior art. A reference to tag damage may be found on page 2, lines 19-21 of the Applicant's specification as filed, however. Notwithstanding the 10/17/2005 Office Action, the Applicant respectfully contends that the Examiner has used impermissible hindsight and a faulty reading of the Applicant's disclosure to combine elements of various references. This is clearly contrary to the requirement of *In re Vaeck*, 947 F.2d 488 that "The teaching or suggestion to make the claimed combination ... must ... be found in the prior art and not based on applicant's disclosure." Further, the Applicant has previously pointed out that separation has not been a problem and that the Examiner's motivation to combine is faulty. Nevertheless, the Examiner did not address this aspect of the Applicant's argument. Instead, the Examiner opted to only provide the standard quotation, "it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper" and citation to *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As noted in § 2144 of the MPEP, a very strong rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination. *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). From this, the Applicant would have been satisfied with the Examiner's motivation to combine references had an advantage or beneficial result cited by the Examiner been produced by their combination. And from *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) and *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), it is clear that the Examiner's motivation to combine references may be for a different purpose or to solve a different problem than that addressed by the Applicant. In other words, the advantage

of the Examiner's combination does not have to be the same advantage obtained by the Applicant. Nevertheless, and contrary to the Examiner's assertions, the Examiner's motivation to combine does not provide an advantage or produce a "beneficial result" related to the Examiner's stated motivation.

The Examiner's claims cited above of "a more secure system...preventing separation of the tag from the system during conveying and handling" cannot reasonably be seen as an "advantage" or a "beneficial result" because there was not a corresponding problem to be solved. As noted above and in the Amendment dated 8/2/2005, separation simply has not been a problem experienced in the prior art, and this alleged separation problem is not found in any reference cited by the Examiner. If there was no problem before the combination, how can there be an advantage or benefit by still having no problem after the combination? At best, the Examiner has not worsened the system in regards to tag separation through his combination of references. The Applicant strongly urges the Examiner to review the given motivation, and the Applicant respectfully requests that the Examiner either (1) provide the Applicant with some suggestion that this alleged separation problem was real, (2) provide the Applicant with a statement that not making a system more susceptible to a previously unexperienced problem is an "advantage" or "beneficial result" under *Linter*, or (3) allow claim 13 and the claims that depend therefrom due to a complete lack of motivation to combine the references of Black ('305), Chapman ('704), and Blankenship ('291).

References Do Not Teach or Suggest All the Claim Limitations

After further reviewing the Examiner's Office Actions dated 10/17/2005 and 6/29/2005, the Applicant stands by the argument that the combination of Black ('305), Chapman ('704) and Blankenship ('291) does not teach or suggest all of the Applicant's claim limitations as required by *In re Vaeck*. There is no teaching in any of the Examiner's references (singularly or in combination) to mount an RFID tag in any recess, much less in an annular recess of a wheel as claimed by the Applicant.

The Examiner has claimed to arrive at such an RFID tag mounted in an annular recess of a wheel by providing the carcass-tracking apparatus of Black ('305), incorporating the annular recess of Chapman ('704) into Black ('305), and then placing the tag as taught by Blankenship ('291). The Examiner has stated that Blankenship ('291) teaches "a RF tag 138 mounted on the surface within the area between the hub and the rim of the wheel (fig. 11; col. 10, lines 8-28)."

Page 9, 10/17/2005 Office Action. The Applicant respectfully disputes that Blankenship ('291) teaches such an arrangement, or the Applicant alternately suggests that the Examiner does not fully appreciate the "on the surface" language. From again reading the text cited by the Examiner and reviewing the cited figure, the Applicant strongly contends that Blankenship ('291) teaches nothing more than placing an RF tag on an outer flange of a reel (or, in the Examiner's words, "on the surface"). According to col. 10, lines 8-11 of Blankenship ('291), the "flange 134 [is] provided with [an RFID tag]", and according to col. 10, lines 16-17 of Blankenship ('291), "an RFID tag or button 138 [is] attached to flange 134". If it were possible to combine the teachings of Blankenship ('291) with those of Black ('305) and Chapman ('704), the tag would be placed on an outer surface of the Chapman ('704) structure, such as the part of the Chapman ('704) flange 28 that is parallel to the Chapman ('704) web 24. Because the Examiner's combination of prior art references does not teach or suggest all of the Applicant's claim limitations in claim 13, directly contrary to the requirements of *Vaeck* noted above, the Applicant respectfully requests allowance of claim 13 and the claims that depend therefrom.

The Possibility that Parts Could Be Rearranged Is Not Dispositive

The Examiner has continued to suggest that "employing the RF tag directly on the wheel instead of on the trolley is simply a rearrangement of parts, and therefore an obvious expedient." Page 5, 10/17/2005 Office Action. However, as the Applicant has previously noted, "The mere fact that a worker in the art could rearrange the parts of the referenced device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). As discussed above, the prior art here clearly does not provide the required motivation, and as such, the Applicant respectfully requests allowance of claim 13 and the claims that depend therefrom.

Claims 14, 20, 21, and 22

The Applicant appreciates the Examiner's attention to claims 14 and 20-22, and the Applicant sincerely suggests that by addressing these claims, the Examiner has aided in moving the prosecution of this application forward. Nevertheless, the Applicant believes claims 14 and 20-22 are patentable for multiple reasons.

First, the Applicant incorporates herein the arguments to "No Motivation to Combine References" made above in relation to claim 13. The Applicant further notes that in rejecting these claims the Examiner uses similar motivation as above to combine Fleischer ('278): "to provide Black et al/Chapman et al/Blankenship et al with an alternative means for securing the tag to the wheel that prevent the tag from separated [sic] from the wheel during transporting." Page 6, 10/17/2005 Office Action, emphasis added. As above, the Applicant respectfully requests that the Examiner either (1) provide the Applicant with some suggestion that this alleged separation problem was real, (2) provide the Applicant with a statement that not making a system more susceptible to a previously unexperienced problem is an "advantage" or "beneficial result" under *Linter*, or (3) allow claims 14 and 20-22 due to a complete lack of motivation to combine the references of Black ('305), Chapman ('704), Blankenship ('291), and Fleischer ('278).

The Applicant also respectfully urges that the Examiner's cited references do not teach or suggest all of the Applicant's claim limitations. The arguments to "References Do Not Teach or Suggest All the Claim Limitations" made above in relation to claim 13 are incorporated herein by reference. Further, the Applicant respectfully disputes that Fleischer ('278) teaches "a block of material shaped to conform to a portion of said first annular recess" as claimed by the Applicant. From reviewing Fig. 1 and col. 4, lines 1-33 of Fleischer ('278) as cited by the Examiner, it is clear to the Applicant that the circuit board of Fleischer ('278) is not "shaped to conform to a portion of [an] annular recess". Instead, the circuit board of Fleischer ('278) is simply located in a casing 12. It is not in fact "shaped to conform" to anything. At best, it is "sized to fit in the casing". Further, the entire casing 12 is being attached to the wheel hub. See col. 2, lines 30-41. However, the casing 12 is also not "shaped to conform" to anything. Because the Examiner's combination of prior art references does not teach or suggest all of the Applicant's claim limitations in claims 14 and 20-22, directly contrary to the requirements of *Vaeck* noted above, the Applicant respectfully requests allowance of claims 14 and 20-22.

Claim 15

Just as there is nothing in the prior art that teaches or suggests placing an RF tag in an annular recess of a wheel, there is nothing in the prior art that teaches or suggests placing an RF tag in a particular annular recess of a wheel as set forth in claim 15. Further, the Examiner has constantly failed to address this limitation, as also noted earlier in the Applicant's Amendment

dated 8/2/2005. Again, all of the Applicant's claim limitations have not been taught or suggested as required by *In re Vaeck*, and as such, the Applicant respectfully requests allowance of claim 15.

Claim 16

There is nothing in the prior art that teaches or suggests imbedding an RF tag in the dampening element of Rohrig ('370), and due to the deformation of the dampening element (col. 3, lines 28-31), there can be no reasonable expectation of success in doing so. As such, these references do not teach or suggest imbedding an RF tag in a first block of material shaped to conform to a portion of said first annular recess, and any expectation of success in imbedding an RF tag in the dampening element of Rohrig ('370) using impermissible hindsight reasoning is dubious. All of the Applicant's claim limitations have not been taught or suggested as required by *In re Vaeck*, and there is no reasonable expectation of success as required by *In re Vaeck*. As such, the Applicant respectfully requests allowance of claim 16.

The Applicant respectfully points the Examiner to MPEP § 706.07, where it is clearly stated that, "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." The Applicant respectfully contends that by not addressing the Applicant's arguments with respect to claim 16, and instead reprinting the Examiner's previous position verbatim, the Examiner has not aided in developing clear issues between the Applicant's position and the Examiner's position or in providing the Applicant a full and fair hearing. The Applicant is at a loss as to how his earlier arguments (presented substantively again above, since the Examiner's rejection is exactly the same now as when those arguments were originally written) were unpersuasive. It is not clear to the Applicant what the issues are between the Examiner's position and the Applicant's position because the Examiner has not responded to the Applicant's position, and the Applicant cannot feel that he has been given a "full and fair hearing" for claim 16. The Applicant respectfully requests allowance of claim 16 or alternately a full and fair hearing for claim 16 that includes a response from the Examiner regarding the Applicant's arguments relating to claim 16.

Claims 17-19 and 24

Claims 17-19 were previously allowed. Claim 17 has been amended to remove the requirement that the fastener extends through the one opening. This limitation was not required by the prior art, this limitation was not earlier required by the Examiner, and claim 17 is patentable without this limitation. As such, the Applicant respectfully requests allowance of claim 17 as currently amended, and allowance of claims 18, 19, and 24 which depend therefrom. In requesting allowance, the Applicant also notes that claims 18, 19, and 24 are allowable independently of claim 17. Claim 24 has been added to clarify that the fastener may include one or more rivet. Antecedent basis for this can be found in the specification as filed at page 7, lines 8-11.

Conclusion

The Applicant believe that no fees are due in connection with this amendment. If any additional fee is due, please charge Deposit Account No. 12-0600.

In view of the above, the Applicant requests allowance of the claims remaining in this application and asks that this application pass to issue.

In view of the above Amendments and Remarks, the Applicant has addressed all issues raised in the Office Action dated 10/17/2005. Should any issues remain, the Examiner is encouraged to telephone the undersigned attorney.

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